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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,734	07/22/2003	Hiroshi Nishikawa	204552029100	6065
25227 7590 02/11/2008 MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				
EXAMINER				
JOERGER, KAITLIN S				
ART UNIT		PAPER NUMBER		
3653				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/623,734

**Applicant(s)**

NISHIKAWA ET AL.

**Examiner**

KAITLIN S. JOERGER

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-7 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09-221248, as cited by applicant.

Regarding claim 1, the JP '248 reference teaches an apparatus for transporting sheets into a fixed image reading position, comprising: a drive roller, 10,; and a pad comprising a lower layer, 51, made of a flexible material and an upper layer, 53, disposed on the lower layer and made of a rigid material with a kinetic friction coefficient of 0.2 or less, the pad being biased to the drive roller so that only the upper layer contacts a peripheral surface of the drive roller to form a nipping region between the drive roller and the pad by a compressive deformation of the flexible lower layer of the pad, wherein the pad is configured within the apparatus so that sheets traveling between the driver roller and the pad do not come in contact with any flexible material that has a kinetic friction coefficient higher than the rigid material of the upper layer, see figure 3.

Regarding claim 6, the JP '248 reference teaches that the pad is biased toward the drive roller by a spring, 28.

Regarding claim 7, the JP '248 reference teaches an apparatus for transporting sheets into a fixed image reading position, comprising: a drive roller, 10; a rigid backup portion, 24,

comprising a top surface facing the driver roller; a lower layer, 51, made of a flexible material and covering the entire top surface of the rigid backup portion; an upper layer, 53, disposed on the lower layer and made of a rigid material with a kinetic friction coefficient of 0.2 or less; and a spring, 28, which biases the rigid backup portion to the drive roller so that only the upper layer contacts a peripheral surface of the drive roller to form a nipping region between the drive roller and the upper layer by a compressive deformation of the flexible lower layer of the pad, see figure 3.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-221248.

Regarding claim 2, the JP '248 reference teaches a flexible lower layer, 51, however the reference does not specifically teaches that the lower layer has a compressive residual strain of 10% or less. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a lower layer in the apparatus taught by JP '248 with a compressive residual strain of 10% or less, since it has been held that where the general condition of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 09-221248 in view of Nakamura et al.

Regarding claim 3, the JP '284 reference teaches all the features of the claimed invention except for the feature that the upper layer of the pad is made of an electrically conductive material, but Nakamura et al. does teach this feature. Nakamura et al. teaches a separation pad with an upper layer, 33g, made of an electrically conductive material, see figure 29 and column 8, line 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of JP '248 as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

Regarding claim 4, JP '248 teaches all the features of the claimed invention except for the feature that the lower layer of the pad is made of an electrically conductive material, but Nakamura et al. does teach this feature. Nakamura et al. teaches a separation pad with a lower layer, 33a, made of an electrically conductive material, see figure 29 and column 8, line 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of JP '248 as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

Regarding claim 5, JP '248 teaches all the features of the claimed invention except the feature wherein an electrostatic charge generated by a contact the upper layer with the sheet is discharged through the lower layer, but Nakamura et al. does teach this feature, see column 8, lines 4+, for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick, see abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use electrically conductive material in the apparatus of JP '248 as taught by Nakamura et al. for the purpose of converting a change in thickness of an original into an electrical signal, for the purpose of detecting a multi-pick.

#### ***Response to Arguments***

Applicant's arguments, see pages 1 and 2 of remarks, filed 1/14/08, with respect to the rejection(s) of claim(s) 1 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly applied prior art to JP 09-221248.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAITLIN S. JOERGER whose telephone number is (571)272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kaitlin S Joerger  
Primary Examiner  
Art Unit 3653

1 February 2008

/Kaitlin S Joerger/  
Primary Examiner, Art Unit 3653